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EXAMINER

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Please find below and/or attached an Office communication concerning this application or proceeding.



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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Paper No. 28

Application Number: 09/117,795

Filing Date: November 10, 1998

Appellant(s): SADO, MITSUO

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GROUP 1700

EXAMINER'S ANSWER

This is in response to the appeal brief filed April 22, 2002.

(1) Real Party in Interest

A statement identifying the real party in interest is contained in the brief.

(2) *Related Appeals and Interferences*

A statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief.

(3) *Status of Claims*

The statement of the status of the claims contained in the brief is correct.

(4) *Status of Amendments After Final*

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) *Summary of Invention*

The summary of invention contained in the brief is correct.

(6) *Issues*

The appellant's statement of the issues in the brief is correct.

(7) *Grouping of Claims*

The appellant's statement in the brief that certain claims do not stand or fall together is not agreed with because appellant has not given a persuasive argument with regard to appellant's statement that each claim stands alone. On page 8, paragraph starting at line 9, appellant states "The dependent claims of the present invention, as seen in Appendix A, are separately patentable and do not stand or fall together. These claims recite further specific elements that have no reasonable correspondence with the JP reference." The examiner submits each of claims 1-4 is obvious over JP 63-069897

and nothing in the dependent claims renders them separable from the issues regarding independent claim 1.

(8) *ClaimsAppealed*

The copy of the appealed claims contained in the Appendix to the brief is correct.

(9) *Prior Art of Record*

JP 63-069897 Kawano 3-1988

(10) *Grounds of Rejection*

The following ground(s) of rejection are applicable to the appealed claims:

Claims 1-4 are rejected under 35 U.S.C. 103(a) as obvious over JP 63-069897 A (see full English translation for citation references). Japanese patent 63-069897 A describes a cleaner composition comprising 5-95 % of one or more amines of mono-, di-, and triethanol amines, 0.2-50 % of one or more high boiling point solvents comprising diethylene glycol monobutyl ether and benzyl alcohol used for removal of heavy dirt attached to hard surfaces. Appellant's claim 1 is drawn to "A releasing agent composition...which comprises as essential components...(A) 5 to 75% by weight of a water-soluble organic solvent represented by the formula $C_4H_9-O-(CH_2CH_2O)_nH$ where n is an integer of 2 or 3". Present claim 2 is drawn to a composition wherein (A) may be diethylene glycol monobutyl ether. JP 63-069897 clearly reads on instant component (A) by disclosing diethylene glycol monobutylether (see page 2 of translation, lines 4 and 5 of part (b)). Per the instant claim 1 requirement of 15 to 40% by weight of benzyl alcohol, JP 63-069897 also clearly discloses benzyl alcohol as a component of the composition (see page 2 of the translation, line 5 of (b)). Appellant recites an amine

Art Unit: 1774

compound in instant claim 1 and a specific amine, alkanolamine, in instant claim 3. JP 63-069897 clearly discloses alkanolamines such as monoethanol amine, diethanol amine, and triethanol amine as part of the composition (see page 2 of translation, line 3 of part (a)). In addition to the JP 63-069897 teaching of all components recited in instant claim 1 parts (A) – (C), the component amounts taught for the JP 63-069897 composition encompass and/or overlap with the ranges recited in instant claim 1.

Appellant requires 10 to 20% by weight of an amine compound, component (C). JP 63-069897 teaches 5 to 95 parts of one or more amines (see page 2, lines 1 and 2 of part (a)), which clearly encompasses the required range of 10 to 20% by weight. Appellant requires 15 to 40% by weight of benzyl alcohol (component (B)) and 5 to 75% by weight of a water-soluble organic solvent represented by the formula $C_4H_9-O-(CH_2CH_2O)_nH$ where n is an integer of 2 or 3. JP 63-069897 teaches 0.2 to 50 parts of a combination of solvents including diethylene glycol monobutylether and benzyl alcohol (see page 2, lines 4 and 5 of part (b)). The JP 63-069897 teaching of 0.2 to 50 parts of a combination of diethylene glycol monobutylether and benzyl alcohol clearly encompasses and/or overlaps with the required amounts of 15 to 40% of benzyl alcohol and 5 to 75% by weight of a water-soluble organic solvent such as diethylene glycol monobutyl ether. Per instant claim 4, the working examples taught by JP 63-069897 describe diluting the cleaning compositions in water (see "Working Examples" page 7 of translation). It would have been obvious to one of ordinary skill in the art at the time of the invention to produce the claimed composition in the recited proportions of

ingredients, since each of the claimed components in the claimed weight ranges are disclosed by JP 63-069897.

(11) Response to Argument

Appellant argues “the Examiner has not established a *prima facie* case of obviousness against the present invention: The Examiner relies on nonanalogous art in rejecting the present claims in view of JP.” In response to applicant's argument that JP 63-069897 A is nonanalogous art, it has been held that a prior art reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the applicant was concerned, in order to be relied upon as a basis for rejection of the claimed invention. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). In this case, the reference is deemed to be within the field of applicant's endeavor. Appellant's claims are drawn to “a releasing agent composition”. The reference applied, JP 63-069897 A, is a cleaner composition for removing polymer from a hard surface (see “Detailed Explanation of the Invention”, pages 2 and 3 of the translation). Appellant further argues on page 6 of the Appeal Brief, “it is believed that the field of the invention relates to aqueous polymer floor polish removal. One skilled in the art would not look to the field of machinery maintenance, such as removing water-insoluble polymers deposited to impart rust resistance to steel plates, or the field of printed circuit board manufacture to address floor polish removal.” The examiner submits that appellant's argument with regard to use of the instant composition “in removing an aqueous polymer floor polish” and discussion with regard to test methods described in JP 63-069897 A is an argument directed to an intended

use of the cleaning composition. In response the examiner states, the intended use of a composition is not patentably significant (see *In re Albertson*, 141 USPQ 730 (CCPA 1964); *In re Heck*, 114 USPQ 161 (CCPA 1957)), and different intended uses for two otherwise similar products is not a basis for a patentable distinction (see *In re Tuominen*, 213 USPQ 89 (CCPA 1982)). Furthermore, "...in apparatus, article, and composition claims, intended use must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim" (see M.P.E.P. § 2111.02, emphasis added). Appellant argues with regard to the stated case law, "These arguments appear to be based on comparison to anticipatory prior art and ignores the fact that the present invention is not anticipated by the JP reference." In response, the examiner submits JP 63-069897 clearly discloses all components of the instant composition in the claimed ranges and is directed to cleaning a hard surface. The JP cleaning composition is deemed capable of performing the intended use.

Appellant also argues "JP teaches away from the present invention by describing a large number of ingredients rather than the specific combinations and amounts of the present invention, and by disclosing the use of ethylene glycol monobutylether where the present invention explicitly excludes the use of that substance". As discussed in the "Grounds of Rejection" stated previously, JP 63-069897 clearly discloses all the components in the requisite amounts per the appellant's claims. The examiner disagrees with appellant's statement that a large number of ingredients is described.

Furthermore, the examiner disagrees with the statement that ethylene glycol monobutylether is explicitly excluded. The instant claims do not exclude ethylene glycol monobutyl ether from being present in the composition. Independent instant claim 1 uses the word "comprising", which allows for ingredients other than the specifically recited components (A) to (C), such as ethylene glycol monobutyl ether, to be present in the composition.

Appellant states "The present invention provides surprising and unexpected results in view of JP." The comparative examples in the instant specification, page 9, compare compositions comprising ethylene glycol mono-n-butyl ether in place of diethethylene glycol mono-n-butyl ether and triethylene glycol mono-n-butyl ether and benzyl alcohol. The examiner submits the comparative data is not commensurate in scope with the prior art, JP 63-069897, and accordingly, is insufficient to establish unexpected results. As previously stated, the instant claims do not exclude ethylene glycol from being present in the composition. Independent instant claim 1 uses the word "comprising", which allows for ingredients other than the specifically recited components (A) to (C) to be present in the composition.

Appellant argues "The amounts broadly disclosed overlap those of the present invention in some cases, but that is not, under the applicable law, a teaching or suggestion of the present invention" (page 9 of the Appeal Brief). In addition, Appellant argues "the Examiner cannot point to anything in the reference suggesting the use of its machinery maintenance or printed circuit board manufacture compositions as aqueous polymer floor polish removers." As stated earlier, JP 63-069897 clearly discloses all

components of the instant composition in the claimed ranges and is directed to cleaning a hard surface. The JP cleaning composition is deemed capable of performing the intended use. A specific teaching of cleaning floors is not required.

In conclusion, the examiner disagrees with appellant that JP 63-069897 A teaches away the present compositions. The examiner has established that each component required by the present cleaning composition is disclosed and taught in the claimed amount by JP 63-069897 A. In addition, both the JP composition and the present composition are cleaning/releasing compositions. Accordingly, the examiner submits a proper *prima facie* case has been established. For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

DG
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June 18, 2002

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